Attachment C

2003 WL 22282265 (Trademark Tr. & App. Bd.)
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*1 THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

Board of Patent Appeals and Interferences

Patent and Trademark Office (P.T.O.)
EX PARTE RICHARD P. POLNIASZEK, XUEBAO WANG, JEFFREY S. DEPUE, CHENNAGIRI R. PANDIT, YADAGIRI PENDRI, AND EDUARDO J. MARTINEZ
Appeal No. 2001-1805
Application No. 09/141,402

NO DATE REFERENCE AVAILABLE FOR THIS DOCUMENT

MARLA J MATHIAS

BRISTOL-MYERS SQUIBB COMPANY

PATENT DEPARTMENT

PO BOX 4000

PRINCETON NJ 08543-4000

Before WINTERS, SCHEINER, and ADAMS

Administrative Patent Judges

ADAMS

Administrative Patent Judge

ON BRIEF

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claim 41, which is the only claim pending in the application and is reproduced below:

41. A high melt **polymorph** of the compound N-(3,4-dimethyl-5-isoxazolyl)-4'- (2-oxazolyl)[1,1'-biphenyl]-2-sulfonamide, which has a melting point of approximately 143.07 to 145.1° C.

The examiner relies on:

Murugesan 5,612,359 Mar. 18, 1997

GROUND OF REJECTION

Claim 41 stands rejected under 35 U.S.C. § 103 as obvious over Murugesan.

DISCUSSION

At the outset, we wish to make it clear that "reliance on per se rules of obviousness is legally incorrect" and must stop. In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). Accord, In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996).

A per se approach would be in conflict with long standing precedent as to the relevance of the method of making a product to the obviousness of the product. Note In re Payne, ("[a]n invention is not 'possessed' absent some known or obvious way to make it.") citing In re Hoeksema, 399 F.2d 269, 274, 158 USPQ 596, 601 (CCPA 1968). In a similar manner, the court in In re O'Farrell, 853 F.2d 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988), in considering the Polisky reference relative to the rejected claims stated "Polisky contained detailed enabling methodology for practicing the claimed invention, a suggestion to modify the prior art to practice the claimed invention, and evidence suggesting that it would be successful." (Emphasis added). See also, In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984)("[t]he prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compounds.")

*2 Since there are no per se rules of obviousness or nonobviousness, each case must be decided upon the facts in evidence in that case. See In re Cofer, 354 F.2d 664, 667, 148 USPQ 268, 271 (CCPA 1966) ("[n]ecessarily it is facts appearing in the record, rather than prior decisions in and of themselves, which must support the legal conclusion of obviousness under 35 U.S.C. § 103"); and Ex parte Goldgaber, 41 USPQ2d 1172, 1176 (Bd. Pat. App. & Int. 1995)("each case under 35 U.S.C. § 103 is decided on its own particular facts.").

We find the examiner's argument (Answer, page 4), "[t]he Court [in] In re Cofer expands upon rather than rejects what the Appellants term a 'purported [per se] rule"' legally flawed and in error. As set forth supra, our appellate reviewing court has made it clear that there are no per se rules of obviousness.

As a second error, we find that the examiner failed to provide any rationale or analysis to support her position in either the Answer or the Final Rejection. For emphasis we reproduce in full the examiner's statement of the rejection from page 3 of the Answer -- "Claim 41 is rejected under 35 U.S.C. [§] 103(a) as being unpatentable over ... Murugesan." In this regard, we suggest the examiner review the Manual of Patent Examining Practice (MPEP) § 706.02(j) for a model of how to explain a rejection under this section of the statute. Furthermore, we direct the examiner's attention to MPEP § 1208, "[a]n examiner's answer should not refer, either directly or indirectly, to more than one prior Office action." In this instance the Answer neither provides a reasoned explanation of the rejection, nor does it direct our attention to any prior Office action where a reasoned analysis of the facts is provided.

Contrary to the examiner's position (Answer page 5) [FN1], we find the N-(3,4-Dimethyl-5-isoxazolyl)-4'-(2-oxazolyl)[1,1'-biphenyl]-2-sulfonamide compound set forth in Example 1(D) of Murugesan to be the most relevant compound to appellants' claimed invention. However, as appellants point out (Brief, page 4) Murugesan "discloses an amorphous form of this compound, having a melting point of 90 to 98° C....." Stated differently, notwithstanding that the claimed compound has the same formula as Murugesan, the examiner has not established that Murugesan suggests appellants' specifically claimed **polymorph**. This is clearly demonstrated by the different melting points for the two compounds.

We note the examiner's analysis of the N-(3,4-Dimethyl-5-isoxazolyl)-4'-(5-oxazolyl)[1,1'-biphenyl]-2-Sulfonamide compound set forth in Murugensan's example 4, wherein she states (Answer, page 6) that a "difference in bonding location would result, as expected in any isomeric situation, in certain differences in physical properties. Here, one such difference is reflected in melting points that range from 189-191° C[] for the Murugesan compound compared to 143-145° C[] for the instantly claimed compound." However, the problem with this argument should be self evident (Answer, page 6), the "compound taught by Murugesan differs from the instantly claimed compound ... at the 5-oxazolyl position...." As appellants argue (Reply Brief, page 2), "[w]hile Example 4 of ... [Murugesan] indeed discloses a crystalline form of a compound having a melting point of 189-191° C, it fails to disclose or suggest the invention of claim 41 ... having a melting point of approximately 143-145° C." Stated another way, they are different compounds.

*3 The claimed invention is drawn to a specific polymorphic form of N-(3,4-

Dimethyl-5-isoxazolyl)-4'-(2-oxazolyl)[1,1'-biphenyl]-2-sulfonamide that has a melting point of approximately 143-145° C. The prior art relied upon by the examiner does not teach this specific **polymorph** as claimed by appellants. The examiner failed to demonstrate that the prior art even recognized that the claimed compound exists in different polymorphic forms, or that there is a known or obvious way to manufacture the specific polymorphic form claimed. Hoeksema. Stated differently, the examiner failed to demonstrate that Murugesan provides an enabling disclosure of the compound set forth in appellants' claim 41. In contrast the examiner has not rejected appellants' claims under 35 U.S.C. § 112, first paragraph, thus the examiner has found on this record that appellants' specification provides an enabling disclosure of how to make and use the claimed invention.

For the foregoing reasons we reverse the rejection of claim 41 under 35 U.S.C. § 103 over Murugesan.

REVERSED

BOARD OF PATENT APPEALS AND INTERFERENCES

Sherman D. Winters

Administrative Patent Judge

Toni R. Scheiner

Administrative Patent Judge

Donald E. Adams

Administrative Patent Judge

FN1. At page 5 of the Answer, the examiner finds that "[e]xample 4 of Murugesan is believed to be the most relevant and most critical to the issue of obviousness for the instant application.".